

Appln No. 09/917,192
Amdt date September 17, 2004
Reply to Office action of May 17, 2004

REMARKS/ARGUMENTS

Applicant appreciates the cooperation shown by the Examiner in the interview conducted on September 17, 2004, and submits the following remarks as requested by the Examiner. Applicant notes with appreciation that the Examiner has indicated that he will contact Applicant's representative telephonically to discuss any newly discovered references on which he intends to reject Applicant's claims in order to expedite prosecution of this case.

Claims 1-14 and 23-32 are pending in the application.

On page 2, claims 1-14 and 23-31 are rejected under 35 U.S.C. 112, second paragraph as indefinite because the limitation "wherein the substantially rigid portion and the substantially elastic portion are of the same plastic" was not understood by the Examiner. In the Examiner's interview conducted on September 17, 2004, the Applicant's representative discussed the "of the same plastic" and the "formed in one piece" limitations, and the Examiner acknowledged that he now understands the meaning of those claim limitations, although he believes that additional prior art may be found to anticipate or make claims 1 and 23 obvious. Applicant was not instructed to amend its claims and assumes, therefore, that the Examiner's indefiniteness rejections to claims 1 and 23 are withdrawn. If the Examiner wishes to discuss alternate wording of the claims in light of this understanding and to avoid a rejection based on new prior art, he is invited to contact Applicant's representative to discuss further.

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On pages 2 and 3 of the Office Action, claims 1-14 and 23-31 are rejected as obvious over *Seijirou* in light of *Seksaria*.

In the telephonic interview of September 17, 2004, the Examiner indicated that, although the above-cited prior art may not teach or suggest all of the limitations of claims 1 and 23 as correctly understood, he believes that additional prior art may be found that teaches or suggests all of the claim limitations. Until such additional prior art is cited, however, Applicant maintains that the Examiner has not made out a *prima facie* case of obviousness of Applicant's claims 1 and 23. Therefore, Applicant respectfully repeats its earlier arguments as follows:

Seijirou relates to a door module system that allows easy adhesion of a door service hole covering 8 to a door main part 7 and a door trim and allow easy separation to correct any position gap in the original adhesion. *Seijirou*, Col. 1 line 48-Col. 2 line 4. To achieve this objective, a film-like sheet 8 is strongly adhered to the door main part 7 through adhesives 6. The door trim 9 is then adhered to an outer periphery of the film-like sheet 8 and fixed to the door main part 7 by grommets. The film-like sheet is perforated in an area between the adhesives 6 on one side of the sheet and adhesives holding the film-like sheet to the door trim 9 on the other. If there is a location gap, therefore, the film-like sheet 8 can be torn along its perforation, separating the door main part 7 and the door trim 9 to allow for readjustment.

The Examiner states that a rigid portion of the "door module (8 and 9)" of *Seijirou* corresponds to the substantially

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rigid portion of long glass fiber reinforced plastic of Applicant's claims 1 and 23 and that the "weatherseal (6)" of *Seijirou* corresponds to the elastic portion. The Examiner has not pointed out which portion of the "door module (8 and 9)" he contends is the "rigid portion" corresponding to the substantially rigid portion in Applicant's claims. If the Examiner contends that the door trim 9 of *Seijirou* is the "rigid portion" of the module, Applicant respectfully submits that the door trim is not even in contact with what the Examiner calls the "weatherseal (6)," (actually adhesives 6) much less "formed in one piece" with the adhesives 6. Moreover, forming the door trim in one piece with the adhesives 6 would render *Seijirou* inoperative, as the objective of easy separation of the door trim 9 with the door main part 7 (which the adhesives 6 are strongly adhered to) would not be addressed.

Applicant will therefore assume that the Examiner believes that the service hole cover 8 of *Seijirou* corresponds to the substantially rigid portion in Applicant's claims. The service hole cover 8 is disclosed in *Seijirou* as a "film-like sheet" which "does not have rigidity and cannot hold a fixed configuration in itself." *Seijirou*, Col. 1 ln. 47-Col. 2 ln. 4. Likewise, the "weatherseal 6" that the Examiner contends corresponds to the substantially elastic portion of the same plastic as the substantially rigid portion are "adhesives 6 of a butyl system." *Seijirou*, Col. 1, lines 35-45. Neither of these elements appears to correspond to Applicant's claim 1.

Seksaria fails to cure this deficiency. The Examiner cites *Seksaria*, Col. 4, lines 35-36 as disclosing a substantially

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rigid portion of long glass fiber reinforced plastic. Applicant respectfully disagrees. The Examiner is correct that this portion of *Seksaria* suggests a mat made of woven "fiber reinforced tapes." Applicant, however, does not agree that this passage teaches or suggests a *substantially rigid* portion of *long glass fiber reinforced plastic*. In fact, *Seksaria* discloses that whatever material is used for the woven mat should have portions that are "freely movable with respect to each other" so that the mat may be freely deformed through "bending, stretching and relative movement of the individual elements." Col. 4, lines 15-20, 35-36. This passage clearly does not teach the use of a substantially rigid portion of long glass fiber reinforced plastic.

Even if, however, *Seksaria* were to disclose a substantially rigid portion of long glass fiber reinforced plastic, the Examiner has not pointed out an appropriate motivation to combine the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The Examiner's only argument for combining the references is an assertion not present in either reference: that fiber reinforced plastic is cheaper to manufacture, stronger and lighter than conventional plastic. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), states that the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."

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Moreover, there is no suggestion or motivation to make the proposed modification if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *Seijirou* states that the service hole cover 8 is "film-like" and is to be torn along its perforation 11 and stay on the door main part 7 when the door trim 9 is removed from the door main part 7 after the grommet 95 holding them together is loosened. See Col. 3, lns 21-32. Applicant finds it difficult to believe that a substantially rigid portion of long glass fiber reinforced plastic would be more suitable than the film-like sheet for the flexible mounting and easy tearing along a perforation that *Seijirou* explains is the purpose of the invention. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Finally, even if 1) there were a motivation to combine the cited references, 2) the combination would not render the service hole cover of *Seijirou* unsatisfactory for its intended purpose, and 3) the adhesive of *Seijirou* were considered a substantially elastic portion of plastic substantially free of long glass fibers, the combined references would still not teach or suggest that these elements are formed in one piece and are of the same plastic.

Applicant cannot find in either of the cited references any teaching or suggestion that the substantially rigid portion and

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substantially elastic portion are of the same plastic. Moreover, Applicant cannot find and the Examiner has not pointed out any teaching or suggestion in the cited references that the substantially rigid portion of fiber reinforced plastic and the substantially elastic portion of plastic substantially free of long glass fibers are in one piece.

The Examiner appears to assert on page 3 of the Office action that the limitation "formed in one piece" would be a *de facto* obvious engineering choice and should be ignored unless an identical objective is stated in the prior art. Applicant respectfully disagrees with this assertion. To reject a claim, all the claim limitations must be taught or suggested by the prior art. See, e.g., *In re Royka*, 490 F.2d 981 (CCPA 1974); and *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art").

As discussed above, Applicant submits that the cited references do not teach or suggest a substantially rigid portion of long glass fiber reinforced plastic and a substantially elastic portion of plastic substantially free of long glass fibers, even in separate pieces. Moreover, "formed in one piece" limitations have been held by the Federal Circuit as distinguishing over prior art and accused devices without a showing of an identical objective in the prior art. See, e.g., *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir., 1997) (prior art reference disclosing two fixedly attached parts would not have anticipated if Applicant specified in its the claims that the parts were "formed in one piece," instead of "integrally

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formed"); and *Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc.*, 887 F.2d 1070, 1074 (Fed. Cir. , 1989) ("nothing yet made of record restricts the terms [e.g., "integral"] to mean 'of one piece']"). In *re Larson*, cited by the Examiner, does not construe the limitation "formed in one piece," but "integral," and differed from the prior art only in that it fixed two separate pieces that were identically disclosed in the prior art. See 52 C.C.P.A. 930, 933 (CCPA, 1965).

Applicant additionally submits that the advantages of the one piece construction over a two piece construction fused or injection moulded together are outlined in the Substitute Specification. Namely, the prior art "integration of seals and other features is limited as is the elasticity of the integrated features due to the structure requirements of the carrier," and the prior art "door modules are produced from a short glass fiber plastic compound...[which is] expensive." *Substitute Specification*, p. 1, paragraph 4. Accordingly, by forming the substantially rigid and elastic portions in one piece from the same plastic, the door module "achieves integration" and "the cost...is reduced." *Substitute Specification*, p. 2, paragraph 1.

For the reasons discussed above, Applicant respectfully submits that: 1) neither *Seijirou* nor *Seksaria* teaches or suggests all of the limitations of claims 1 and 23; 2) there would be no motivation to combine the references and; 3) even if combined, the references would fail to teach or suggest all of the limitations of Applicant's claim 1. Applicant therefore


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submits that claims 1 and 23 and their dependent claims 2-14 and 23-31 are allowable.

Applicant notes with appreciation that the Examiner has indicated claim 32 is allowable.

As mentioned above, Applicant welcomes a supplemental telephonic interview with the Examiner if new prior art is discovered or if the Examiner envisions a reason for rejection of the claims.

Respectfully submitted,
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